

REMARKS

As originally filed, the above-referenced patent application included claims 1-26. In an October 29, 2002 office action, claims 1-26 of this application were subjected to a restriction requirement, in which the Examiner asserted that claims 1-20 (i.e., the "Group I" claims) and claims 21-26 (i.e., the "Group II" claims) of this application were directed to distinct inventions.

The Examiner further asserted that the Group I claims were directed to several patentably distinct species of the invention recited in the Group I claims. Specifically, the Examiner identified the following allegedly patentably distinct species:

Species I – Figures 1-6;
Species I(A) – Species I being modified by Figure 11;
Species II – Figures 7-10;
Species II(A) – Species II being modified by Figure 11;
Species III – Figures 12A-12C;
Species IV – Figures 14A-14C;
Species IV(A) – Figure 15;
Species IV(B) – Figure 16;
Species V – Figures 17-19C; and
Species VI – Figures 23-25C.

The Examiner required election of a single disclosed species for prosecution on the merits in the event that no generic claim - claim 1 was indicated as being generic by the Examiner - was finally held to be allowable.

In their November 21, 2002 response to the October 29, 2002 office action, Applicants elected (i.e., restricted the application to) the claims within Group I (i.e., claims 1-20) and indicated that pending claims 1-3, 5 and 9 read upon Species II.

On February 4, 2003, the Examiner mailed a second office action, which acknowledged Applicants' claim elections, and which withdrew claims 4, 6-8 and 10-26 from further consideration due to those claims being directed to a non-elected species and due to there not yet being any allowed generic claim. Nowhere within the February 4, 2003 office action did the Examiner object to either (a) Applicants' November 21, 2002 claim elections, or (b) Applicants' characterization that claims 1-3, 5 and 9 read upon Species II.

Also in the February 4, 2003 office action, the Examiner indicated that each of claims 3, 5 and 9 was allowable over the prior art, but were objected to based on (a) depending from a rejected base claim and any intervening claims, and (b) the objection to claim 1, from which each of claims 3, 5 and 9 depended.

In their April 23, 2003 response to the February 4, 2003 office action, Applicants amended claim 1 to include the features of original claim 3, which, therefore, was cancelled. This, in turn, rendered claim 1 allowable. Moreover, because both original claim 1 and original claim 3 had previously been identified – without objection by the Examiner – as falling within Species II, this also rendered allowable at least claims 2, 5 and 9 of this application because each of these claims (a) depended from amended claim 1, and (b) read on Species II.

However, in the July 15, 2003 Office communication, the Examiner now asserts that claim 1 is not generic and that claim 1 only reads upon Species I, not Species II.

In support the Examiner contends that "the elected species II does not have 'an end plane of said inside electrode located only within said ink chamber trench is exposed at said another end plane' . . . particularly when the filling member 26 (see Figure 8) [has] completely filled the portion at said another end." The Examiner then adds that "hence, the end plane of said inside electrode cannot . . . possibly be exposed to said another end plane as recited in claim 1" and, therefore, the previous election is "improper because none of the claims of Group I [reads] on the elected Species II."

Applicants respectfully disagree with the Examiner's conclusion, which has greatly inconvenienced Applicants by virtue of being made for the first time so late during prosecution of the instant application. Applicants acknowledge that the features of claim 1 read on Species I; however, the features of claim 1 also read on Species II, and read on Species III, IV, IV(A), IV(B), V, and VI as well.

Regarding Species II, the Examiner indicated – in the October 29, 2002 office action - that Species II was depicted in/by Figures 7-10 of this application, and the Examiner has not subsequently refuted this indication in either the February 4, 2003 office action or the July 15, 2003 office communication.

As noted at page 27, lines 8-9 of this application, "Figs. 7-11 correspond to a second embodiment of the present invention," which is discussed, *inter alia*, between page 27, line 7 and page 30, line 8 of this application. At page 27, lines 27-32 of this application, it is noted that the excessive portion of the conductive member 26 and metal electrode 10 at the top plane of sidewall 11 are removed by lapping. And as noted in Figure 2, metal electrode 13 extends from one side plane (sidewall 11) to another side plane (the side opposite to sidewall 11) of the trench 8 that is provided in the piezoelectric plate 27. In this state, the trench is filled with conductive member 26 as shown in Figure 8.

This demonstrates that the end plane of metal electrode 13 is exposed at the other end plane side of the piezoelectric plate 27, and, in turn, underscores that the Figures 7-10 embodiment (i.e., the Species II embodiment) of the present invention does, in fact, cover the feature "an end plane of said inside electrode located only within said ink chamber trench is exposed at said another end plane" that is recited in pending claim 1. As noted above, Applicants believe that this feature is covered by both the embodiment depicted in Figures 1-6 (i.e., the Species I embodiment) and the embodiment depicted in Figures 7-10 (i.e., the Species II embodiment).

Therefore, at least claims 1, 2, 5 and 9 are in condition for allowance because (a) claim 1 reads on Species II, and because (b) the Examiner has not objected to Applicants' indication (in their November 21, 2002 response to the October 29, 2002 office action) that claims 2, 5 and 9 read on Species II, and because (c) claims 1, 2, 5 and 9 have been indicated as allowable.

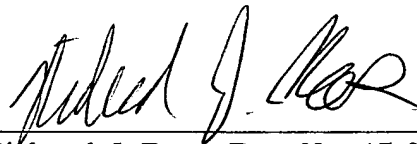
In view of at least the remarks provided above, Applicants respectfully request reconsideration of the Examiner's assertions in the July 15, 2003 office communication and further request immediate allowance of at least pending claims 1, 2, 5 and 9, as well as any other claims to which claim 1 is generic.

If the undersigned can be of any assistance in advancing the prosecution of this case, the Examiner is invited to contact him through the information given below.

Respectfully submitted,

Date: August 8, 2003

By: _____



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